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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,355	01/24/2002	Bruce Bradshaw	P05141US0	8052

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MCKEE, VOORHEES & SEASE, P.L.C.
801 GRAND AVENUE
SUITE 3200
DES MOINES, IA 50309-2721

EXAMINER

MAI, TRI M

ART UNIT PAPER NUMBER

3727

DATE MAILED: 05/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,355

Applicant(s)

BRADSHAW, BRUCE

Examiner

Tri M. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification fails to teach an upper portion fully protecting a golf club. It seems that Fig. 1 show a portion of the club that is not protected. This is a new matter rejection.

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is confusing what comprises the invention. The claim defines a cover, but the body of the claim positively recites structural elements of toe end of a golf club head. Is the invention a cover or a cover/club head combination? Applicant is required to state whether a subcombination or a combination is intended, and amend the claim to clarify the matter.

Claim Rejections - 35 USC § 102

3. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Sander (5547193). Sander teaches a cover with a protective cover, a clip, and an open portion of clip capable of facing a direction of opposite a toe end of the club head, i.e., the club as shown in Fig. 8 can be rotated such that the clip facing a direction opposite a toe end of the club head at portion 20A.

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4. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by either Aldcroft (5944081) or Philippi (4213614), or Bucklin (2035529). Aldcroft teaches a cover having a protective pocket at portion 12, a lower portion along portion 116 for protecting a portion of the shaft of the club. The lower portion having spaced apart sidewalls as shown in Fig. 14, and a clip 104.

Philippi teaches a cover having a protective pocket, and a lower portion with space sidewalls at portion 15 as shown in Fig. 2, and a clip 15A for securing the sidewalls to the shaft.

Bucklin teaches a cover having a protective pocket, and a lower portion with space sidewalls at portion as shown in Fig. 1, and a clip 24 for securing the sidewalls to the shaft.

Claim Rejections - 35 USC § 103

5. Claims 1-6, and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaffney (4898222) in view of Sander. Gaffney teaches a golf club head cover including a protective head cover, a partially open collar extending upwardly and outwardly. Gaffney meets all claimed limitations except for the resilient clip. Sander teaches that it is known in the art to provide a resilient clip 22. It would have been obvious to one of ordinary skill in the art to provide a resilient clip in Gaffney as taught by Sander to provide an alternative attachment means for the collar of the golf club.

Regarding claims 8 and 9, Gaffney teaches an interior lining as shown in the cross section of Fig. 6. It would have been obvious to one of ordinary skill in the art to provide the clip between the two layers in Gaffney as taught by Sander to protect the club from scratching.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Gaffney rejection and further in view of Thompson (4378832). The Gaffney rejection meets all claimed

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limitations except for the clip being made from metal. Thompson teaches that it is known in the art to make a clip 40 from metal. It would have been obvious to one of ordinary skill in the art to make the clip from metal in the Gaffney rejection as taught by Thompson to provide added strength and/or durability.

Response to Arguments

7. Applicant's arguments filed 03/17/03 have been fully considered but they are not persuasive. With respect to the Gaffney in view of Sander combination, applicant argues that there is no motivation to use the clip. On the contrary, Sander provides clear evidence and motivation to use the clip in a cover similar to that of Gaffney. Sander teaches that the clip enable one to insert the golf club easily and conveniently (col. 1, lines 33-34).

Furthermore, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, to substitute one attachment means by hook and loop fasteners with one using clip is clearly within one of ordinary skill in the art for providing an alternative attachment means.

With respect to the cover being extending upwardly and outwardly, it is submitted that the collar in Gaffney (Figs. 2 and 5) extends upwardly at open portion 19 and outwardly as claimed, i.e, it opens up upwardly and outwardly.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (703)308-1038. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W Young can be reached on (703)308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3579 for regular communications and (703)305-3579 for After Final communications.

**TRI M. MAI
PRIMARY EXAMINER**

T. Mai